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PAUL W. MARTIN
NCR CORPORATION, LAW DEPT.
1700 S. PATTERSON BLVD.
DAYTON, OH 45479-0001

EXAMINER	
CHAMPAGNE, DONALD	
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK G. MCGREGOR and BRET J. BESECKER

Appeal 2008-4042
Application 09/832,767
Technology Center 3600

Decided: February 2, 2009

Before: MURRIEL E. CRAWFORD, HUBERT C. LORIN, and DAVID B. WALKER, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the Non-Final Rejection of claims 14, 15, 17 to 19, 21 to 25, and 27. Claims 1 to 13, and 26 have been cancelled and claims 16 and 20 are objected to.

The claimed invention is directed to a system for generating revenue using electronic mail. Claim 14, reproduced below, is further illustrative of the claimed subject matter.

> 14. A method for generating revenue using electronic mail, comprising the steps of:
>
> transmitting an e-mail message addressed to at least one e-mail recipient from a first client computer to a host server through at least one computer network, wherein the e-mail message comprises an e-mail address of an e-mail user, an e-mail address of the at least one e-mail recipient, a subject, and a body;
>
> appending advertisement retrieval software means to the e-mail message transmitted from the first client computer, wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements retrievably stored in a database;
>
> transmitting the e-mail message from the host server to a second client computer through the at least one computer network based upon the e-mail address of the at least one e-mail recipient; and
>
> displaying the e-mail message on the second client computer, wherein when the e- mail message is first displayed on the second client computer the advertisement software retrieval means is operable at the second client computer to retrieve at least one of the advertisements retrievably stored in the database for display with the e-mail message on the second client computer.

The references of record relied upon by the Examiner as evidence of obviousness are:

Park US 2001/0025254 A1 Sep. 27, 2001

Microsoft Press Computer Dictionary (3rd Ed. Microsoft Press, 1997).

Claims 14, 15, 17 to 19, 21, 22, 24, 25, and 27 stand rejected under 35 U.S.C. § 102(e) as anticipated by Park.

Claim 23 stands rejected under 35 U.S.C. § 103 as unpatentable over Park.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the Appellants and the Examiner. As a result of this review, we have reached the conclusion that the applied prior art does not establish the prima facie obviousness of the claimed subject matter. Therefore the rejections on appeal are reversed. Our reasons follow.

The following comprise our finding of facts with respect to the scope and content of the prior art and the differences between the prior art and the claimed subject matter. Park discloses a method for advertising and generating revenue [0022]. An electron stamp is appended to an email before the email is sent from a first client computer [0022, 0046]. The stamp includes advertisement [0041].

The disagreement between the Appellants and the Examiner is with respect to whether Park discloses that the email is sent from the first client computer without an appended advertisement. The Appellants argue that in the claimed invention, the host server receives the email without an

advertisement appended, appends the advertisement to the email and then sends the email to the second client computer. We note that the Examiner does not argue that the claims do not require that the email is first sent by the first client computer without the appended advertisement with the advertisement appended by the host server. As we found above, it is clear from the disclosure of Park that the stamp containing the advertisement is appended to the email by the first client computer and thus does not read on the recited limitations in independent claims 14, 18, and 21. We are thus in agreement with Appellants that Park does not anticipate the subject matter of independent claims 14, 18, and 21 and claims 15, 17, 19, 22, 24, 25, and 27 dependent therefrom.

We also find nothing in Park to suggest the sending of an email from a first client computer and then appending an advertisement at the host server after the email is sent and, as such, we will not sustain the rejection of claim 23 which is dependent on claim 21 under 35 U.S.C. § 103 as being unpatentable over Park.

The Examiner's decision is REVERSED.

REVERSED

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PAUL W. MARTIN
NCR CORPORATION, LAW DEPT.
1700 S. PATTERSON BLVD.
DAYTON, OH 45479-0001